



500.38963VX1/E5372-02MX

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ryuji KOHNO *et al.*
Serial No. : 10/625,566
Filed : 24 July 2003
For : PROBE STRUCTURE
Group AU : 2829
Examiner : E.F. Karlsen
Conf. No. : 8112

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

27 January 2005

Sir:

In response to the Office Action dated 27 December 2004 in connection with the above-identified application, the following remarks are respectfully submitted.

PENDING CLAIMS

Claims 1-11 were pending in the application, under consideration and subject to examination at the time of the Office Action. At entry of this paper, Claims 1-11 remain pending in the application for consideration and examination.

RESTRICTION/ELECTION REQUIREMENT - TRAVERSED

A restriction/election requirement has been made for the reasons given on page 2 of the Detailed Action. Applicant respectfully traverses the requirement based upon the following grounds.

PRIOR PROSECUTION - NO SERIOUS BURDEN FOR EXAMINATION

As directed by MPEP §803, if a search and an examination of an entire application can be made without serious burden, the Examiner **must** examine the application on the merits even though the application includes claims to distinct or independent inventions. Applicant's position is that it would not create a serious burden on the part of the USPTO to conduct a continued search and examination of the entire application, i.e., as evidence in support of such position, Applicant respectfully points out the fact that Office Action comments admit that the alleged Group I (Claims 1-5) and Group II (Claims 6-11) are commonly classified within Class 324, Subclass 754, and thus are related subject matter.

Even presuming *arguendo* that one could establish that the subject matter recited in the claims at issue relating to respective embodiments of the present invention relate to independent and distinct inventions as required by 35 USC §121, it is respectfully submitted that, since the claims are related by class/subclass and would not impose additional searching, it is established that examination of all of the claims presently pending in the application would pose no additional burden.

As no serious burden has been, or could be, shown, EXAMINATION OF THE ENTIRE APPLICATION IS REQUIRED IN ACCORDANCE WITH THE CONTROLLING PROVISIONS OF MPEP §803, and Applicant respectfully requests that the restriction/election requirement be withdrawn.

REQUIREMENT INSUFFICIENTLY SUPPORTED

The Examiner has the initial burden to support the restriction/election requirement, and it is respectfully submitted that the Examiner has failed to meet such initial burden in this particular instance. More specifically, Office Action comments (largest paragraph on page 2) attempting to show support, at first recite MPEP requirements for showing combination/subcombination distinction, but in following Office Action comments (attempting to meet such requirements), the Office Action comments appear simply to reiterate the requirements again without significant substance or analysis. Accordingly, Applicant respectfully submits that the requirement is unsupported, and should be withdrawn.

PROVISIONAL ELECTION

In order to comply with the requirement, Applicant provisionally elects, with traverse, for prosecution on the merits, Group I, including at least Claims 1-5.

NO ADMISSION - RESTRICTION/ELECTION

Applicant submits that the instant response (including the comments submitted and the provisional election) is not an admission on the record that the respective species are separately distinct species and/or obvious variants.

CONTINUATION(S)/DIVISIONAL(S) FOR NON-ELECTED SUBJECT MATTER

Despite any traversal set forth in other parts of this paper regarding any restriction/election, one or more related (e.g., continuation/divisional) applications

may be filed to pursue subject matter not elected in the present application.

Applicant submits that any filing of continuation(s)/divisional(s) should not be taken as any prejudice, admission or disclaimer that the restriction/election is correct, but instead, is merely use of separate applications to move the other subject matter through the patenting process.

CONTINUATION(S)/DIVISIONAL(S) - DOUBLE PATENTING PROHIBITED

Regarding any related continuation/divisional application(s) filed to pursue subject matter identical to or consonant with restriction/election subject matter not elected in the present application, it is respectfully submitted that the third sentence of 35 USC §121 and MPEP §804.01 prohibit any double-patenting rejection between this and the related continuation/divisional applications.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, early allowance of such claims is respectfully requested.

This Response is being filed within the shortened statutory period for response set by the 27 December 2004 Office Action, and no Petition is required for entry of this paper. To whatever other extent is actually proper and necessary, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. Further, no additional fees are required for entry of this paper. Please charge any proper and necessary fee to ATS&K Deposit Account No. 01-2135 (as Case No. 500.38963VX1).

Respectfully submitted,



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